



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,358	10/15/2001	Stephen Lange Ranzini	3892-4002	6886

27123 7590 05/10/2005

MORGAN & FINNEGAN, L.L.P.
3 WORLD FINANCIAL CENTER
NEW YORK, NY 10281-2101

EXAMINER

GREENE, DANIEL L

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 05/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/981,358

Applicant(s)

RANZINI ET AL.

Examiner

Daniel L. Greene

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-106 is/are pending in the application.
- 4a) Of the above claim(s) 1-7, 10-29, 53, 54, 60, 61, 63, 65, 67, 69 and 72-106 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8, 9, 30-52, 55- 59, 62, 64, 66, 68, and 70-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 3/10/2005 have been fully considered but they are not persuasive.

2. Status Of The Claims

3. Claims 1-106 are pending in this application, of which all but the claims 1-7, 10-29, 53-54, 60-61, 63, 65, 67, 69, and 72-106 are withdrawn from consideration. This withdrawal selection is based upon the Applicant's correspondence dated 10/15/2004 in which was written, "...elect for prosecution the invention of Group III(claim 8 and those depending therefrom) ."

4. The Examiner notes that the Applicant has reversed the status of the claims in their remarks and claimed that claim 8 and those depending therefrom have been withdrawn.

Claim Rejections - 35 USC § 112

5. The Applicant in response to the Rejection Under 35U.S.C. & 112 for the dependent claims 56-58 submits, " The Office Action rejects independent claims under 35 U.S.C. 112, second paragraph, ... The Examiner submits that claims 56-58 are dependent claims in the original action and there appears to not be any Amendments that would render claims 56-58 independent. Further, the Applicant argues that the rejection is effectively resolved by directing the Examiner's attention to p. 19, lines 17-23 of the disclosure of the present application. The section referred to contains the term "... might need to alter ..." which maintains the rejection under 35 U.S.C. 112, second

Art Unit: 3621

paragraph, and renders the section as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6.

Claim Rejections - 35 USC § 103

The Applicant argues that the primary reference, Anderson, does not disclose, teach, or suggest for electronically transferring funds between two entities that involves the use of electronic mail messages. A reference is to be considered not only for what it expressly states, but also for what it would reasonably have suggested to one of ordinary skill in the art. *In re DeLisle*, 160 USPQ 806 (CCPA 1969). However, the reference details the types of electronic documents that have a record mapping to a particular environment, such as a legacy environment of a banking network. As detailed in the Office Action, Figure 3 and its detailed description contained in paragraphs 0174-0179 discloses electronically transferring funds between two entities that involves the use of electronic mail messages.

In reference to the Applicant disagreeing with the combination of the two references to establish a prima facie case of obviousness, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re Simon*, 174 USPQ 114 (CCPA

Art Unit: 3621

1972); In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA 1969). Both of the references are teaching about the methods of conducting electronic commerce transactions with Anderson providing the specific limitations and Ginter expanding the protective shell around the economic transactions. The Applicant discloses that there is a discussion in the art for the motivation to modify references or to combine references. p.5, 2nd paragraph. Further, the Applicant has not disclosed where in either of the references there are teachings away from combining or using with a reference in the related field.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 56-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independent claim discloses the transfer of electronic cash from one bank to another. Claim 56-58 discloses real-time access for official government research that is associated with econometric and law enforcement. The Applicant has not provided the motivation and/or logic how claims 56-58 depend on claim 8.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 8, 9, 30-52, 55, 59, 62, 64, 66, 68, and 70-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 20010018739A1-Anderson et al. [Anderson `739], and further in view of US 6,427,140-Ginter et al. [Ginter `140]**

As per claim 8:

Anderson '739 disclose:

a first entity transmitting to the first entity's clearing bank a cash request electronic mail message, said message requesting that an electronic representation of cash be sent to a specified second entity; Fig. 3, 0174-0175

the first entity's clearing bank transmitting as an electronic mail message attachment to the second entity's clearing bank, Fig. 3, 0176-0177.

Anderson `739 discloses the claimed invention except for a digital rights management vault containing said electronic representation of cash. Ginter `140 teaches that it is known to utilize the concept of placing data into a VIDE content container/digital rights management container and associating control information with said data. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a VIDE content container/digital rights management container as taught by Ginter `140, since Ginter `140 states at Col. 22, lines 15-25 that

such a modification would eliminate the constraints of having to use a few high level individual, pre-defined content provider increments.

As per claim 9:

Anderson '739 further disclose:

the second entity's clearing bank sending an electronic mail message to the first entity's clearing bank requesting receipt of the actual funds corresponding to said electronic representation of cash. [0226]

As per claim 30:

Anderson '739 and Ginter '140 further disclose:

wherein said digital rights management container relies on a security system which is based on an open standard cryptographic method by Anderson '739 [0073-0075] and Ginter '140 Fig. 10, Col. 8, lines 1-10 and Col. 67, lines 1-50,

Anderson '739 and Ginter '140 discloses the claimed invention including, determining the identity of the requestor, the authority of the requestor, predetermined rules, open standard cryptographic method, avoiding fraud, selecting the authentication method, etc. It would have been obvious to one having ordinary skill in the art at the time the invention was made to perform authentication protocols such as determining the identity of the requestor, authority of the requestor, predetermined rules, open standard cryptographic method, avoiding fraud, selecting the authentication method, etc. Anderson '739 Fig. 17 A/B and Ginter '140 Fig. 10.

As per claim 31:

Anderson '739 and Ginter '140 further disclose:

employing a message set order protocol and dataset that are proprietary; and publishing the application protocol interfaces corresponding to said message set and set dataset as an open standard. Anderson '739 [00730075] and Ginter '140 Fig. 10, Col. 8, lines 1-10 and Col. 67, lines 1-50,

Anderson '739 and Ginter '140 discloses the claimed invention including, determining the identity of the requestor, the authority of the requestor, predetermined rules, open standard cryptographic method, avoiding fraud, selecting the authentication method, etc. It would have been obvious to one having ordinary skill in the art at the time the invention was made to perform authentication protocols such as determining the identity of the requestor, authority of the requestor, predetermined rules, open standard cryptographic method, avoiding fraud, selecting the authentication method, etc. Anderson '739 Fig. 17 A/B and Ginter '140 Fig. 10.

As per claim 32:

Anderson '739 further discloses the claimed invention except for accessing the databases of synergistic services. It would have been obvious to one having ordinary skill in the art at the time the invention was made to access any type or style of databases since it was known in the art that the protocol for accessing databases is well known as taught by Anderson '739. Fig. 24, [0252].

As per claim 33:

Anderson `739 further discloses the claimed invention except for accessing the database directory of user's profiles and attributes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to access any type or style of databases since it was known in the art that the protocol for accessing databases is well known as taught by Anderson `739. Fig. 24, [0252].

As per claim 34:

Anderson `739 further discloses the claimed invention except for accessing the database of aliases of users. It would have been obvious to one having ordinary skill in the art at the time the invention was made to access any type or style of databases since it was known in the art that the protocol for accessing databases is well known as taught by Anderson `739. Fig. 24, [0252].

As per claim 35:

Anderson `739 further discloses the claimed invention except for accessing the database of pending transactions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to access any type or style of databases since it was known in the art that the protocol for accessing databases is well known as taught by Anderson `739. Fig. 24, [0252].

Art Unit: 3621

As per claim 36:

Anderson `739 further discloses the claimed invention except for accessing the database for validation services. It would have been obvious to one having ordinary skill in the art at the time the invention was made to access any type or style of databases since it was known in the art that the protocol for accessing databases is well known as taught by Anderson `739. Fig. 24, [0252].

As per claim 37:

Anderson `739 further discloses the claimed invention except for accessing the database of eCheck numbers. It would have been obvious to one having ordinary skill in the art at the time the invention was made to access any type or style of databases since it was known in the art that the protocol for accessing databases is well known as taught by Anderson `739. Fig. 24, [0252].

As per claim 39:

Anderson `739 further discloses the claimed invention except for accessing the database of user authorities. It would have been obvious to one having ordinary skill in the art at the time the invention was made to access any type or style of databases since it was known in the art that the protocol for accessing databases is well known as taught by Anderson `739. Fig. 24, [0252].

As per claim 40:

Anderson `739 further discloses the claimed invention except for accessing the database of auditing services. It would have been obvious to one having ordinary skill in the art at the time the

Art Unit: 3621

invention was made to access any type or style of databases since it was known in the art that the protocol for accessing databases is well known as taught by Anderson '739. Fig. 24, [0252].

As per claim 41:

Anderson '739 further discloses the claimed invention except for accessing the database of ERP data. It would have been obvious to one having ordinary skill in the art at the time the invention was made to access any type or style of databases since it was known in the art that the protocol for accessing databases is well known as taught by Anderson '739. Fig. 24, [0252].

As per claim 42:

Anderson '739 further disclose:

wherein said database of ERP data secures its data pervasively using digital rights management. 0175-0180

As per claim 43:

Anderson '739 discloses the claimed invention except for utilizing XML compilers to speed up transaction rates and data processing speeds for ERP enabled messages. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to utilize XML compilers to speed up transaction rates and data processing speeds for ERP enabled messages since it is known in the art that XML compilers speed up transaction rates and data processing speeds for ERP enabled messages.

Art Unit: 3621

.As per claims 44-48:

Anderson `739 discloses the claimed invention except for the providing customer service in the forms of a help wizard, self-executing software diagnostic tool, and an ERP help wizard. Ginter `140 teaches that it is known to provide customer service. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide customer service as taught by Ginter `140, since Ginter `140 states at Col. 26, lines 35-67 that such a modification would support user interaction.

As per claim 49:

Anderson `739 discloses the claimed invention, as discussed above, for performing a settlement using a bank payment system. It would have been an obvious matter of design choice to modify the teachings of Anderson `739 and Ginter `140 to provide performing a settlement using a bank payment system regardless of the terms used to describe the same action/entity be it, a first entity or customer or user, etc, be it using an ATM POS system, interfacing with a currency exchange provider, a conventional bank, performed in an automated manner etc. Since the applicant has not disclosed that using different names to describe the same thing solves any stated problem in a new or unexpected way or is for any particular purpose which is unobvious to one of ordinary skill and it appears that the claimed feature does not distinguish the invention over similar features in the prior art since, the teachings of Anderson `739 and Ginter `140 will perform the invention as claimed by the applicant with any method, means, or product to perform a settlement using a bank payment system.

As per claim 50:

Anderson '739 further disclose:

performing settlement using an ATM POS system. [0222]

As per claim 51:

Anderson '739 further disclose

interfacing with a currency exchange service provider. [0224]

As per claim 52:

Anderson '739 further disclose

wherein said steps are performed in an automated manner. [0175-0177]

As per claim 55:

Anderson '739 further disclose

generating messages to transfer to a conventional bank the funds corresponding to said electronic representation of cash. [0226]

As per claim 59:

Anderson '739 further disclose

placing time-based limitations on the validity of said electronic representation of cash. [0242]

As per claim 62:

Anderson '739 further disclose
providing real-time transfer of the finds corresponding to said electronic
representation of cash. [0226]

As per claim 64:

Anderson '739 further disclose
allowing a user requesting said transmission to select the authentication method
to be used to access said descriptive data and said electronic representation of cash.
[0226]

As per claim 66:

allowing said entities to establish subordinate users who may have similar or
lesser authorities than a primary user.[0224]

As per claim 68:

further comprising the step of requiring a user requesting the transmission of said
vault to select that a standard privacy matrix template be used to access said
descriptive data and said digital representation of money. [0226]

As per claim 70:

Anderson '739 further disclose
screening said electronic mail messages for viruses or other malicious code.

[0174]

As per claim 71:

Anderson '739 further disclose
protecting users from spam, denial of service attacks or other malicious
interference. [0174]

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 571-272-6707. The examiner can normally be reached on M-Thur. 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

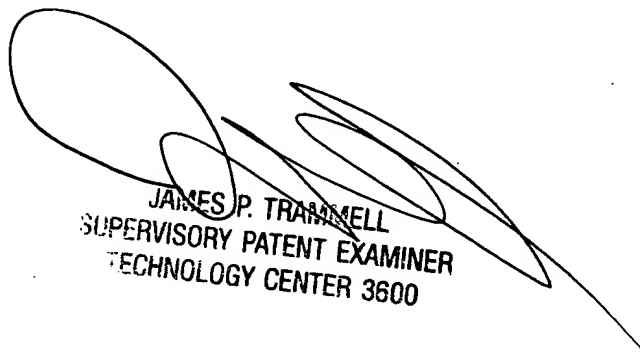
Art Unit: 3621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel L. Greene
Examiner
Art Unit 3621

5/2/2005

7.



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600